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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,644	11/21/2003	Ben Montano	BRY-002.01	1261

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ARTZ & ARTZ, P.C.
28333 TELEGRAPH RD.
SUITE 250
SOUTHFIELD, MI 48034

EXAMINER

CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/719,644		MONTANO ET AL.	
	Examiner		Art Unit	
	Mike Chambers		3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 24, 26 and 28 are rejected under 35 U.S.C. 103(a) as obvious over Hoult (3702702). Hoult discloses a two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 2). . It would have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2 : Hoult discloses an upper and lower arm and connecting portion (fig 2).

As to claims 3 and 4 : Hoult discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 2).

As to claim 5 : Hoult discloses a length that is substantially the entire length (fig 2).

As to claim 6 : Hoult discloses upper and lower arms (fig 2).

As to claims 7-9, 11-13,14-16 : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10: Hoult discloses bases and rails (fig 2).

As to claim 17: Hoult discloses a molded plastic head (fig 2, 2:13-16).

As to claim 24: Hoult discloses one or more projections (fig 3).

As to claim 26: Hoult discloses a semi-oval shape (fig 3).

As to claim 28: See claim 1 rejection. Hoult discloses a concave depression (fig 2).

Also,

Claims 1-13, 17-23 and 28 are rejected under 35 U.S.C. 103(a) as obvious over Collinson (6213901). Collinson discloses a two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 1,2). . It would have been obvious matter of design choice to a

person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2: Collinson discloses an upper and lower arm and connecting portion (fig 1,2).

As to claims 3 and 4: Collinson discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 1,2).

As to claim 5: Collinson discloses a length that is substantially the entire length (fig 1,2).

As to claim 6 : Collinson discloses upper and lower arms (fig 1,2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9: The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : Collinson discloses a bases and rails (fig 1,2).

As to claims 11-12 : Collinson discloses a convex shape (fig 1,2). The cross section would naturally be convex in shape. And the throat has a convex shape. The

specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 13 : Collinson discloses a concave shape (fig 1,2).

As to claim 17 : Collinson discloses a molded plastic head (fig 2, 1:57-58).

As to claims 18-19: See claim 1 rejection.

As to claims 20-22: Collinson discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 28: See claim 1 rejection. Collinson discloses a concave depression (fig 1).

Also,

Claims 1-28 are rejected under 35 U.S.C. 103(a) as obvious over Morrow (6066056). Morrow discloses a two sidewalls extending outward from the two side surfaces

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of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 1,2). It would have been obvious matter of design choice to a person of ordinary skill in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2: Morrow discloses an upper and lower arm and connecting portion (fig 2).

As to claims 3 and 4 : Morrow discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 2).

As to claim 5 : Morrow discloses a length that is substantially the entire length (fig 2).

As to claim 6 : Morrow discloses upper and lower arms (fig 2). The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9, 11-13,14-16, : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of

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ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : Morrow discloses a bases and rails (fig 2).

As to claims 11-12 : Morrow discloses a convex shape (fig 2). The cross section would naturally be convex in shape. And the throat has a convex shape. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 13 : Morrow discloses a concave shape (fig 1,2).

As to claim 14 : Morrow discloses projections (fig 1,2 item 54).

As to claim 15 : Morrow discloses projections separated by a width less than the diameter of a lacrosse ball (fig 1,2 item 54).

As to claim 16 : Morrow discloses a semi-oval shape (fig 2,4).

As to claim 17 : Morrow discloses a molded plastic head (fig 2, 3:1-2).

As to claims 18-19, 24 : See claim 1 rejection.

As to claims 20-22: Morrow discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2,4). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It

would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 25: Morrow discloses projections separated by a width less than the diameter of a lacrosse ball (fig 1,2 item 54).

As to claim 26 : Morrow discloses a semi-oval shape(fig 2,4).

As to claim 27 : Morrow discloses a molded plastic head (fig 2, 3:1-2).

As to claim 28: See claim 1 rejection. Morrow discloses a concave depression (fig 1,2).

Also,

Claims 1-13,18-19 and 28 are rejected under 35 U.S.C. 103(a) as obvious over LeMire (20020107094). LeMire discloses a two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 1,3b). It would have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention

because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2: LeMire discloses an upper and lower arm and connecting portion (fig 3b).

As to claims 3 and 4 : LeMire discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 3b).

As to claim 5 : LeMire discloses a length that is substantially the entire length (fig 3b).

As to claim 6 : LeMire discloses upper and lower arms (fig 3b). The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9, 11-13,14-16, : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : LeMire discloses a bases and rails (fig 3b).

As to claims 11-12 : LeMire discloses a convex shape (fig 3b). The cross section would naturally be convex in shape. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 13 : LeMire discloses a concave shape (fig 3b).

As to claims 18-19: See claim 1 rejection.

As to claim 28: See claim 1 rejection. LeMire discloses a concave depression (fig 3a,3b).

Claims 14-17, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMire as applied to claim 1 above, and further in view of Kohler et al (6916259). Kohler et al discloses the use of projections (fig 3). It would have been obvious to one of ordinary skill in the art to have utilized the projections of Kohler with the device of LeMire in order to provide a deeper pocket for those players who desire a deeper pocket and increase their satisfaction.

As to claim 15 : Kohler discloses projections separated by a width less than the diameter of a lacrosse ball (fig 3).

As to claim 16 : LeMire discloses a semi-oval shape (fig 2,3b).

As to claim 17 : LeMire discloses a molded plastic head (fig 1,3b,9:47-62).

As to claim 24 : See claim 14 rejection.

As to claims 20-22: LeMire discloses an upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2, 3b). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It

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would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 25: Kohler discloses projections separated by a width less than the diameter of a lacrosse ball (fig 3).

As to claim 26 : Kohler discloses a polygon shape(fig 3).

As to claim 27 : LeMire discloses a molded plastic head (fig 1,3b,9:47-62).

Comments

The applicant is directed to the following section of the MPEP. The specification fails to disclose any surprising or unexpected result from the design modifications to a lacrosse head. Therefore these broad claims with little structural limitations are merely obvious design choices that would be obvious to one of ordinary skill in the art.

M.P.E.P. Section 2144.04

B. Changes in Shape

In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

Although the applicant is welcome to include "boiler plate" comments concerning obviousness rejections, it is strongly recommended that the focus of the response be on what the applicant believes the novelty and non-obviousness of their instant invention is. And how this improvement differs from existing lacrosse heads.

Response to Arguments

Applicant's arguments filed 11/02/06 have been fully considered but they are not persuasive. The specification fails to disclose any surprising or unanticipated results for the instant invention. The existing claim language merely calls for a portion of the length of the sidewall to be sized and shaped to permit the rolling of a lacrosse ball along a portion of the sidewall. In theory, any concave area placed on the sidewall surface could broadly be read as infringing the instant invention. Since the sidewall has an inner and outer area, the existing claim language could read on all lacrosse heads since a lacrosse ball in the inner area of the head would naturally meet the existing limitations. The specification provides no surprising or unanticipated results from this limitation; therefore it is considered a design choice and is not a patentable feature.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

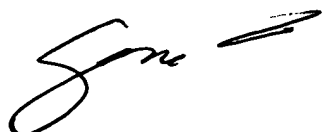
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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January 12, 2007

Michael Chambers
Examiner
Art Unit 3711


EUGENE KIM
SUPERVISORY PATENT EXAMINER